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EXAMINER

SAFAVI, MICHAEL

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3637

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/531,622
Filing Date: April 14, 2005
Appellant(s): FOELL ET AL.

John H. Hornickel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 23, 2009 appealing from the Office action mailed May 27, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is substantially correct. However, it is noted that the brief sets forth a summary of the embodiment of panel illustrated in Fig. 6. Although Appellant may feel that claim 1 is generic to the point of encompassing what is shown by Fig. 6 it should be kept in mind that in response to a species election the Applicant had elected the species of panel described by "panel having one straight surface w/male portions having first projections parallel to

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each other and to the wall and second projections perpendicular to each other” as recited within amended claim 13 in the response of April 06, 2007. Such an embodiment as defined by amended claim 13 in the April 06, 2007 response does not encompass what is illustrated in Fig. 6 for the reasons set forth within the Advisory action of August 13, 2008 and again in the Office action of November 13, 2008. See also, the Advisory action of August 03, 2009. The rejection of claims 1, 6 and 8 would apply whether reading claims 1, 6 and 8 on the elected embodiment as recited within amended claim 13 in the response of April 06, 2007, (see paragraph bridging pages 5 and 6 of the specification), or on the embodiment of panel illustrated by Fig. 6. It should be noted that the only mention of that elected embodiment defined by amended claim 13 in the April 06, 2007 response appears within that paragraph bridging pages 5 and 6 of the specification.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant’s statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 1, 6, and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to have originally disclosed an “apparatus...consisting of: a wall panel, wherein the wall panel consists of one substantially flat wall and two wall panel ends and a male engagement portion at each end, wherein each male engagement portion consists of a fin, wherein both fins extend from one side of the wall panel”. The specification does not appear clear and complete as to such an apparatus.

Claims 1, 6, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, it is not clear as to what is being defined by “apparatus...consisting of: a wall panel, wherein the wall panel consists of one substantially flat wall and two wall panel ends and a male engagement portion at each end, wherein each male engagement portion consists of a fin, wherein both fins extend from one side of the wall panel”. The specification does not appear clear and complete as to such an apparatus particularly, with respect to the elected species of the invention to “having one straight surface w/male portions having first projections parallel to each other and to the wall and second projections perpendicular to each other”.

It is not clear as to what is being defined by claim 6 with claim 6 apparently introducing a further element or feature to the invention defined by claim 1. Claim 1 is written in a closed-end format, (i.e., ‘consisting of’ format which would limit the invention defined by claim 1 to only those features set forth within the language of claim 1.

Claim Rejections - 35 USC § 102

Claims 1, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Elderson 6,021,618. Elderson discloses, Fig. 1, a wall panel (14), wherein the wall panel consists of one substantially flat wall (18) and two wall panel ends and a male engagement portion (20), (sections extending outwardly from wall (18) along one side thereof), at each end, wherein each male engagement portion (20) consists of a fin, (the respective section extending outwardly from wall (18)) or (the foot portion of the L-shaped flange (20) thereof), wherein both fins extend from one side of the wall panel. The wall panel has perforations (22), col. 3, lines 56-65.

(10) Response to Argument

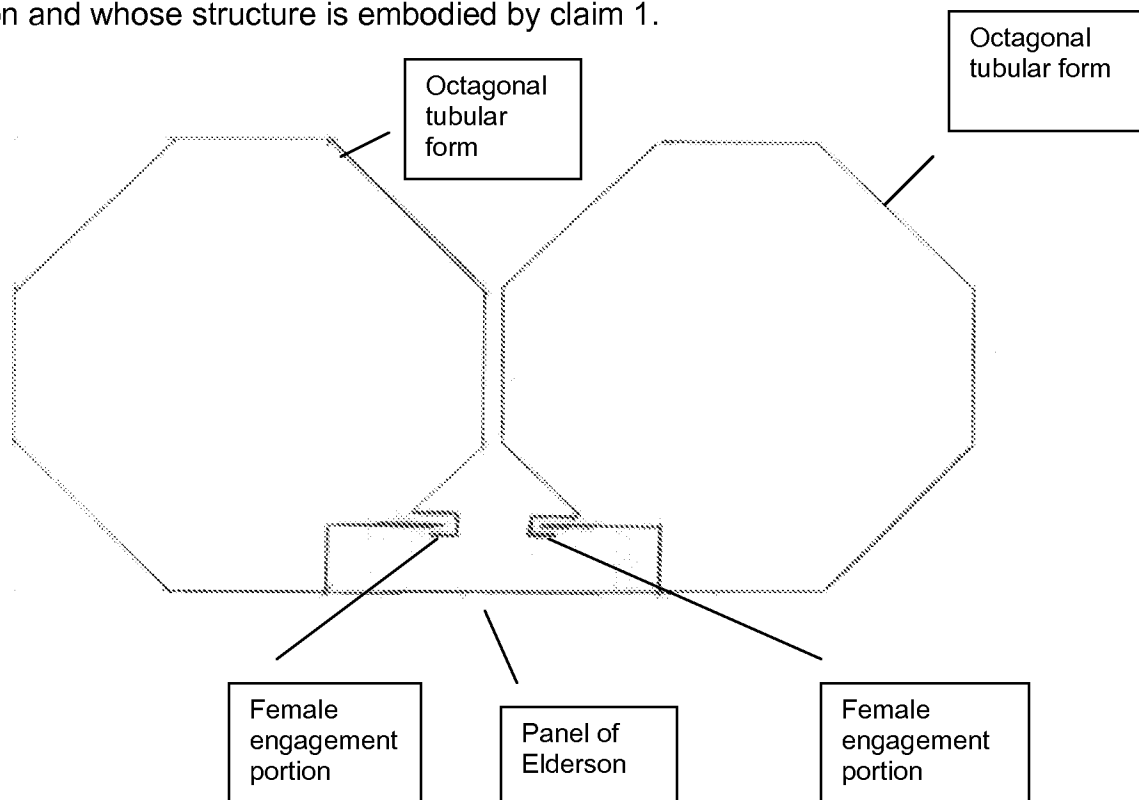
As for Applicants' argument against the rejection of claims 1, 6, and 8 under 35 U.S.C. 112, the instant disclosure, even with reference to Fig. 6, does not set forth and had not originally set forth the limitations recited within claim 1. For example, if addressing Fig. 6, it appears that even what is illustrated in Fig. 6 has more than "a fin" at either "engagement portion". Also, the instant disclosure does not set forth that any of the embodiments are of solely any given elements. Therefore, the instant specification does not provide support for the language of claim 1. Appellant references a fin (28) while arguing that "each male engagement portion consists of a fin (28)". However, Fig. 6 clearly discloses at least two fins (28) along each male engagement portion (26). See, for example, lines 19-22 on page 24 of the specification. Further, as illustrated in for example, Figs. 6, 9, 10, 34, 35, 36, 37, 38, and 39, there appears a "nib" or initial extension out of the "substantially flat wall" from which the fins emanate. As such, the embodiment of panel illustrated by Fig. 6 as argued by Appellant has at least a "substantially flat panel", two "extensions" or "nibs", and at least four fins. Claim 1 calls for only one "substantially flat panel" and only two fins. Thus, claim 1, 6 and 8 are not supported by the original disclosure and do not find support within the instant specification.

As for Applicants' arguments against the applied prior art, Applicant appears to be arguing an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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structure is capable of performing the intended use, then it meets the claim. In this case, each male engagement portion 20 of Elderson including each fin, (e.g., all of 20 or the respective section extending outwardly from portion 20, [i.e., the foot portion of the L-shaped flange 20 thereof]), can “engage a matching female engagement portion”. Thus, Elderson as along 20 can engage respective matching female engagement portions of any two elongated octagonal form elements. Claims 1, 6 and 8 appear directed to nothing more than a panel. No particular octagonal form elements are positively claimed thus, no particular form assembly is positively defined within claims 1, 6 and 8.

In any event, one can see from the examiner’s rendition illustrated below that the “panel” of Elderson can indeed be used with and engage respective matching female engagement portions of any two elongated octagonal form elements. See also, appellant’s embodiment of Figure 35 which has the same structural characteristics as Elderson and whose structure is embodied by claim 1.



(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael Safavi/
Primary Examiner, Art Unit 3637
M. Safavi

Conferees:

Darnell Jayne /dj/

Lanna Mai /lm/